

Applic. No. 09/933,054

Amdt. dated October 12, 2004

Reply to Office action of June 11, 2004

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 1-6, 8, and 12-25 remain in the application.

In the second paragraph on page 2 of the Office action, claims 1, 12-14, 20-22, 24, and 25 have been rejected as being obvious over by Pasqualini et al. (U.S. Patent No. 4,617,759) (hereinafter "Pasqualini") in view of Kordes et al. (U.S. Patent No. 4,053,972) (hereinafter "Kordes") under 35 U.S.C. § 103.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claims 1, 15, 16 and 21 call for, *inter alia*:

Applic. No. 09/933,054

Amdt. dated October 12, 2004

Reply to Office action of June 11, 2004

an outer paneling having a free edge portion and being made from a metallic material, an inner paneling having an edge portion and being made from metallic material.

The Kordes reference very briefly describes a refrigerator door having a door face and a door drum (inner panel) both made of metal (column 1, lines 17-20). Kordes discloses that the refrigerator door includes a metal bridging strip, which is welded to and connects the edges of the drum to the edges of the door face. It is noted that column 1 of Kordes pertains to the background of the invention and not to Kordes's invention. However, the disclosure pertaining to the actual invention of Kordes pertains to refrigerator doors having an outer metal panel and an inner plastic panel member. The other refrigerator doors cited by Kordes are for example in U.S. Patent No. 3,078,003 and in U.S. Patent No. 3,359,053 (column 2, lines 58-66).

The Pasqualini reference discloses a refrigerator door having a steel sheet outer door and a plastic counterdoor (column 1, lines 16-22 and column 3, lines 6-19). Pasqualini does not disclose or consider alternative materials for the door sheet or the counterdoor. Therefore, the teaching of Pasqualini does not provide a person of ordinary skill in the art with any motivation for using different materials for the steel

Applic. No. 09/933,054

Amdt. dated October 12, 2004

Reply to Office action of June 11, 2004

sheet door shell or for the plastic counterdoor. Pasqualini most definitely does not provide a person of ordinary skill in the art any motivation to substitute the plastic counterdoor with a counterdoor made of metal.

Because Kordes pertains mainly to refrigerator doors having a metal outer paneling and a plastic inner paneling and Pasqualini only discloses a refrigerator door with a metal outer paneling and a plastic inner paneling, a person of ordinary skill in the art is not motivated by the teaching of Kordes to modify the refrigerator door disclosed in Pasqualini to provide a refrigerator door where both the inner panel and the outer panel are made of metal.

Furthermore, the profile (1) connecting the metal door shell (16) and the counterdoor (17) of the refrigerator door disclosed in Pasqualini does not need to thermally uncouple the door shell (16) and the counterdoor (17). Moreover, Kordes is completely silent about the issue of thermally uncoupling two panelings made from metallic material. Therefore, a person of ordinary skill in the art is not motivated by Pasqualini in view of Kordes to equip a refrigerator door having an outer and an inner paneling both made from metallic material with a couple connecting the two

Applic. No. 09/933,054

Amdt. dated October 12, 2004

Reply to Office action of June 11, 2004

panelings, wherein the couple thermally uncouples the panelings.

The references do not show or suggest an outer paneling having a free edge portion and being made from a metallic material, an inner paneling having an edge portion and being made from metallic material, as recited in claims 1 and 21 of the instant application.

Since claims 1 and 21 are believed to be allowable over Pasqualini in view of Kordes, dependent claims 12-14, 20, 22, 24, and 25 are believed to be allowable over Pasqualini in view of Kordes as well.

In the first full paragraph on page 3 of the Office action, claims 1-6, 8, and 12-25 have been rejected as being obvious over Kordes (U.S. Patent No. 4,053,972) in view of Kiel (U.S. Patent No. 5,193,310) under 35 U.S.C. § 103.

The Kiel reference discloses a refrigerator door having an outer paneling and an inner paneling, where the outer paneling is a metal outer shell and the inner paneling is an injection molded plastic pan (column 1, lines 13-25 and column 2, lines 20-30).

Applic. No. 09/933,054

Amdt. dated October 12, 2004

Reply to Office action of June 11, 2004

Because Kiel explicitly discloses that a refrigerator door is generally constructed out of a metal outer shell and an injected molded plastic pan (inner panel), and Kordes pertains mainly to refrigerator doors having a metal outer paneling and a plastic inner paneling, a person of ordinary skill in the art is not given any motivation by Kiel to modify the refrigerator door disclosed by Kordes to have inner and outer panelings made of metal.

Furthermore, the couple connecting the outer shell (12) and the inner liner pan (14) of the refrigerator door disclosed in Kiel does not need to thermally uncouple the outer shell (12) and the inner liner pan (14). Moreover, Kordes is completely silent about the issue of thermally uncoupling two panelings made from metallic material. Therefore, a person of ordinary skill in the art is not motivated by Kordes in view of Kiel to equip a refrigerator door having an outer and an inner paneling both made from metallic material with a couple connecting the two panelings, wherein the couple thermally uncouples the panelings.

As seen from the above-given comments, Kordes in view of Kiel does not show or suggest an outer paneling having a free edge portion and being made from a metallic material, an inner paneling having an edge portion and being made from metallic

Applic. No. 09/933,054

Amdt. dated October 12, 2004

Reply to Office action of June 11, 2004

material, as recited in claims 1, 15, 16 and 21 of the instant application.

Since claims 1, 16, and 21 are believed to be allowable over Kordes in view of Kiel, dependent claims 2-6, 8, 12-14, 17-20, and 22-25 are believed to be allowable over Kiel in view of Kordes as well.

The following further remarks pertain to the rejection of the claims over Pasqualini in view of Kordes and to the rejection of the claims over Kordes in view of Kiel.

The Kordes reference was filed in 1977. The Pasqualini reference was filed in 1983 and still did not consider providing a refrigerator door with an outer and inner paneling both made out of metal. Even nine years later, when the Kiel reference was filed, a refrigerator door with an inner and outer paneling both made out of metal, was not practiced in the art, which is clear from the statement in Kiel that a refrigerator door is generally constructed out of a metal outer shell and an injection molded plastic pan (column 1, lines 14-25). In other words, even though it was theoretically known in the art in 1977 to use metal for the inner and outer panelings, it still was not practiced in the art fourteen years later. Therefore, a person of ordinary

Applic. No. 09/933,054

Amdt. dated October 12, 2004

Reply to Office action of June 11, 2004

skill in the art still would only contemplate improvements on refrigerator doors having an outer paneling made out of metal and an inner paneling made of plastic. Improvements on refrigerator doors having a metal inner liner and a metal outer liner are still not common.

Because the teaching of Kordes is primarily concerned with refrigerator doors having a metal outer paneling and a plastic inner paneling and improvements on refrigerator doors having metal inner and metal outer panels are not practiced in the art, there is no motivation for a person of ordinary skill in the art to use an insulating couple for connecting the edge portions of a metal inner paneling with the edges of a metal outer paneling, as is recited in the instant application, based on the combination of Pasqualini and Kordes or based on the combination of Kordes and Kiel.

Moreover, a critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614,1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the

Applic. No. 09/933,054

Amdt. dated October 12, 2004

Reply to Office action of June 11, 2004

invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453,1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125,1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50

Applic. No. 09/933,054

Amdt. dated October 12, 2004

Reply to Office action of June 11, 2004

USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id. When an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

Upon evaluation of the examiner's comments, it is respectfully believed that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims. Accordingly, the examiner is requested to withdraw the rejection.

Applic. No. 09/933,054

Amdt. dated October 12, 2004

Reply to Office action of June 11, 2004

Additionally, Kordes discloses that a serious drawback of welding, screwing, or bolting the two panelings together is the relative movement between the inner and outer surfaces of the door. Kordes discloses overcoming only this mentioned drawback, by introducing the retainer, which allows relative movement between the inner and outer surfaces of the door. Kordes is absolutely silent about thermal coupling or uncoupling of two panelings of a refrigerator, when the two panelings are made from metallic material. Consequently, contrary to the present invention, Kordes does not suggest a refrigerator door having two panelings made from metallic material, wherein a couple connects both panelings and wherein the couple thermally insulates the panelings from each other. Accordingly, the Kordes reference teaches away from the use of a metal inner panel and a metal outer panel.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 1, 15, 16, and 21. Claims 1, 15, 16, and 21 are, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claims 1, 16, or 21 they are believed to be patentable as well.

Applic. No. 09/933,054
Amdt. dated October 12, 2004
Reply to Office action of June 11, 2004

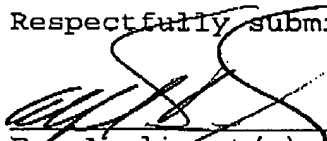
In view of the foregoing, reconsideration and allowance of
claims 1-6, 8, 12-25 are solicited.

In the event the Examiner should still find any of the claims
to be unpatentable, counsel respectfully requests a telephone
call so that, if possible, patentable language can be worked
out.

Petition for extension is herewith made. The extension fee
for response within a period of one month pursuant to Section
1.136(a) in the amount of \$110 in accordance with Section 1.17
is enclosed herewith.

Please charge any other fees which might be due with respect
to Sections 1.16 and 1.17 to the Deposit Account of Lerner &
Greenberg P.A., No. 12-1099.

Respectfully submitted,


For Applicant(s)

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